



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,639	02/21/2002	Paul A. Cronic	2401 CIP	9753

7590 06/29/2005

SAWYER LAW GROUP LLP
P.O. Box 51418
Palo Alto, CA 94303

EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,639

Applicant(s)

CRONCE, PAUL A.

Examiner

Bradley B. Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 1 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>July 22, 2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is in response to application filed 21 February 2002. Claims 1-14 are presented for examination on the merits.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on July 22, 2003 is in compliance with the provisions of 37 CFR 1.97 and therefore considered by the examiner.

Claim Objections

Claims 1 and 7 are objected to because of the following informalities: They recite a “method for *deliver* of a license...” Applicant may revise to “*delivering*” to correct this grammatical error. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Venkatesan et al. (hereinafter Venkatesan), US 6,898,706 B1.

As per the following claims, Venkatesan discloses:

1 A method for deliver of a license-managed toolset for creating a license-managed software product, the method comprising the step of:

Art Unit: 3621

(a) providing an authorization process, the authorization process including the steps of:

- (i) creating a first public and private key pair for a software publisher (fig 7, step 800),
- (ii) creating a second public and private key pair for a software program (fig 7, step 800),
- (iii) creating an authorization program for the software program, and embedding a copy of the first and second public keys in the authorization program (fig 7, step 850),
- (iv) combining the authorization program with a software program, such that when the software program is invoked on a computer, the authorization program obtains a license for the software program by (fig 7, publisher, authority and client):
 - (1) creating a license request (fig 8, 860 license request via link),
 - (2) encrypting a license request using the second public key (fig 8, 870 encrypts fingerprint),
 - (3) transmitting the encrypted license request to a key authority (fig 8, 340),
 - (4) receiving an encrypted license from the key authority, wherein the license includes license terms (fig 7, license download to each client), and
 - (5) decrypting the license using the first public key, such that the license terms are used to control use of the software program (fig 7, step 1300);

(b) implementing the authorization process in the software toolset that is provided by a toolset publisher, wherein when the authorization process is invoked in the software toolset, the toolset publisher is the publisher in the authorization process and the software toolset is the software program in the authorization process (fig 7, step 1400), and

(c) implementing the authorization process in the software product that is provided by a publisher of the software product using the software toolset, wherein when the authorization

Art Unit: 3621

process is invoked in the software product, the publisher of the software product is the publisher in the authorization process and the software product is the software program in the authorization process, whereby both the software toolset and the software product use the same authorization process to obtain respective licenses (figure 5, publisher-client authorization process).

2 The method of claim 1 further includes the step of transferring the first and second private keys to a key authority for receiving license requests and generating licenses (fig 8, watermarking authority 340).

3 The method of claim 1 further includes the step of including product and customer information within the license request and license documents (fig 11, CID, PID, steps 1115, 1122).

4 The method of claim 1 further includes the step of associating the license request with a financial transaction, and incorporating financial transaction information within the license (fig 11, step 1115 payment information 1122 license generation).

5 The method of claim 1 further includes the steps of: (a) assigning a publisher ID to the publisher, (b) embedding the publisher ID within the authorization program, (c) including the publisher ID within the license, and (d) comparing the embedded publisher ID with the publisher ID within the license to verify the publisher of the software program to be authorized has generated the license (fig 11, step 1122).

Art Unit: 3621

6 The method of claim 1 further including the steps of: (a) generating a machine fingerprint within the authorization process, (b) incorporating the machine fingerprint within the license request, (c) incorporating the machine fingerprint within the license terms, and (d) using by the authorization program the machine fingerprint to prevent use of the software product on a different machine than the one which made the license request (fig 11, step 1122).

7 A method for deliver of a license-managed toolset for creating a license-managed software product, the method comprising the step of:

(a) providing an authorization process, the authorization process including the steps of: (i) creating a first public and private key pair for a software publisher, and creating a first certificate with the public key using a certificate authority (column 13, lines 18-34), (ii) creating a second public and private key pair for a software program, and creating a second certificate with the software publisher private key (column 13, lines 25-34), (iii) creating an authorization program for the software program, and embedding a copy of the first and second certificates and second private key in the authorization program (column 13, 35-48), (iv) combining the authorization program with a software program, such that when the software program is invoked on a computer, the authorization program obtains a license for the software program by: (1) creating a formatted license request, (2) signing the license request using the second public key, (3) transmitting the signed license request to a key authority, (4) receiving an signed formatted license from the key authority, wherein the license includes license terms, and (5) validating the license using the first certificate, such that the license terms are used to control use of the software program (fig 7 and as detailed in the above rejection of claim 1);

Art Unit: 3621

(b) implementing the authorization process in the software toolset that is provided by a toolset publisher, wherein when the authorization process is invoked in the software toolset, the toolset publisher is the publisher in the authorization process and the software toolset is the software program in the authorization process (fig 7, 1400), and

(c) implementing the authorization process in the software product that is provided by a publisher of the software product using the software toolset, wherein when the authorization process is invoked in the software product, the publisher of the software product is the publisher in the authorization process and the software product is the software program in the authorization process, whereby both the software toolset and the software product use the same authorization process to obtain respective licenses (fig 5, publisher-client authorization process).

8 The method of claim 7 further includes the step of including product and customer information within the license request and license documents (see claim 3 above).

9 The method of claim 7 further includes the step of associating the license request with a financial transaction, and incorporating financial transaction information within the license (see claim 4 above).

10 The method of claim 7 further includes the step of formatting the license request and license using a proposed signed XML document format (column 11, lines 1-23, note that XML encoding may occur within HTML content; XML DTD describes a subset of HTML 4.0 for embedded use within other XML).

11 The method of claim 7 further includes the step of generating the first public and private key pair for the software product publisher during the authorization process for the toolset, using the steps of: (a) creating the first public and private key pair for the software publisher prior to using the authorization process for the toolset; (b) including the public key within the license request document in the form of a certificate request; (c) receiving the certificate within the license document, and (d) using the received certificate in conjunction with the private key as the first key pair in the authorization process for the software product (see process in fig 5 and as detailed above rejected claims).

12 The method of claim 7 further includes the step of transferring the first and second private keys and certificates to a key authority for receiving license requests and generating licenses (fig 8, step 900 watermarking authority 340).

13 The method of claim 7 further includes the steps of: (a) assigning a publisher ID to the publisher, (b) including the publisher ID within the publisher certificate, included within the software product license, (c) embedding the publisher ID within the authorization program, (d) comparing the embedded publisher ID with the publisher ID within the certificate to verify the publisher of the software program to be authorized has generated the license (fig 11, steps 1115, 1122).

14 The method of claim 7 further including the steps of: (a) Generating a machine fingerprint

Art Unit: 3621

within the authorization process, (b) incorporating the machine fingerprint within the license request, (c) incorporating the machine fingerprint within the license terms, and (d) using by the authorization program the machine fingerprint to prevent use of the software product on a different machine than the one which made the license request (fig 11, steps 1115, 1122).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

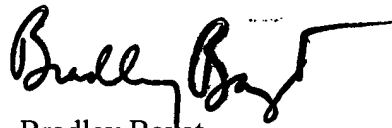
- US Patent 6,611,812 B2 to Hurtado et al.
- US Patent 6,904,523 B2 to Bialick et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8am-6: 30pm.

Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Bradley Bayat', with a stylized flourish extending to the right.

Bradley Bayat
Art Unit 3621
Patent Examiner